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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,473	08/05/2003	Amy Mac Bunker	PC25243A	6825

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT PAPER NUMBER

1624

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,473

Applicant(s)

BUNKER ET AL.

Examiner

Venkataraman Balasubramanian

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-8 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 9, 10 and 12 is/are rejected.
- 7) ☒ Claim(s) 3, 4 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/8/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group III, claims 1-12 drawn to compound of formula I wherein Y is CH₂, C=O, CHR⁷, along with election of forth species of claim 8, in the reply filed on 9/19/2005 is acknowledged. Claims 1-12 will be examined to the extent they embrace the elected subject matter.

Non-Elected Subject Matter

Claims 1-4, 9 and 11 include non-elected subject matter. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 10 is an improper dependent claim as it depends on compound claim 1 and then composition claim 9. It is not clear why composition of compound claim1 has

Art Unit: 1624

any bearing on the composition of compound claim 8. An appropriate correction is needed.

2. Claim 12 is an improper dependent claim. Note claim 12 depends on claim 1 and claim 8. The method of use as recited is dependent on both the compound of claim 1 and claim 8 and hence claim 12 should be rewritten to include only compound 8.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Motesharei et al., US 6,452,009.

Motesharei et al. teaches several 1-oxoisoquinoline compounds for treating bacterial infection, which include instant compounds. See column 2, formula of line 35-45 and note the definition of various variable groups. Particularly note all variable groups, X, Y, Z, R₁, R₂, R₃, R₄, R₅, R₆ and R₇ of the formula overlap with corresponding groups in the instant formula I. See entire document. Especially see column 33-122 for examples and Table showing various compounds made. More specifically, when instant R² is substituted phenyl alkenyl, with the given definitions of other variables compounds taught by Motesharei et al include instant compounds.

Claims 1, 2 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Marlowe et al., US 2002/0058677.

Marlowe et al. teaches several 1-oxoisoquinoline compounds for treating thrombosis, which include instant compounds. See page 3, formula I and note the definition of various variable groups. Particularly note all variable groups, X, A, Z, D, E, J, G, R¹ and R¹¹ of the formula I overlap with corresponding groups in the instant formula I. See entire document. See Scheme I-Scheme 3 of pages 17-20 and note the intermediate compounds include instant compound. Especially see examples 1-24 of pages 22-25 including the Table showing various compounds made which include instant compounds.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

Art Unit: 1624

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motesharei et al., US 6,452,009.

Teachings of Motesharei et al. as discussed in the above 102 rejection is incorporated herein. As noted above, Motesharei et al. teaches several 1-oxoisoquinoline compounds for treating bacterial infection, which include instant compounds.

Motesharei et al. differs from the instant claims in exemplifying only limited number compounds with variable overlapping with the instant variable groups.

However, Motesharei et al. teaches equivalency of those compounds taught in column 33-122 with those generically recited in column 2 for formula of line 35-45. Particularly note all variable groups, X, Y, Z, R₁, R₂, R₃, R₄, R₅, R₆ and R₇ of the formula overlap with corresponding groups in the instant formula I.

Thus it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds using the teachings of Motesharei et al and expect resulting compounds to possess the uses taught by the art in view of the equivalency teaching outline above.

Claims 1, 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marlowe et al., US 2002/0058677.

Teachings of Marlowe et al. as discussed in the above 102 rejection is incorporated herein. As noted above, Marlowe et al. teaches several 1-oxoisoquinoline compounds for treating thrombosis, which include instant compounds.

Marlowe et al. differs from the instant claims in exemplifying only limited number compounds with variable overlapping with the instant variable groups.

However, Marlowe et al. teaches equivalency of those compounds taught in pages 22-25, examples 1-24, with those generically recited in page 3 for formula I. Particularly note all variable groups, X, A, Z, D, E, J, G, R¹ and R¹¹ of the formula I overlap with corresponding groups in the instant formula I.

Thus it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds using the teachings of Marlowe et al and expect resulting compounds to possess the uses taught by the art in view of the equivalency teaching outline above.

Allowable Subject Matter

Claims 5-8 are allowed. Claims 3, 4 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and excluding non-elected subject matter.

Art Unit: 1624

Conclusion

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Acting Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

Venkataraman Balasubramanian
Venkataraman Balasubramanian

10/15/2005